

Application No.: 09/991,151

9

Docket No.: 532782000100

REMARKS**Interview request**

Applicants respectfully request a telephonic interview after the Examiner has reviewed the instant response and amendment. Applicants request the Examiner call Applicants' representative at 858 720 5133.

Status of the Claims***Pending claims***

Claims 1 to 35 are pending (please note: the office action lists claims 1 to 22 as pending, and claim 22 as withdrawn).

Claims added in the instant amendment

Claims 36 to 48 are added. Claims 22 to 35 have been withdrawn. Thus, after entry of the instant amendment, claims 1 to 21 and 36 to 48 will be pending and under consideration.

Outstanding Rejections

Claims 1 to 21 stand rejected under 35 U.S.C. §102(a) as allegedly anticipated by Ong (2000) J. Chromatography 313:57-64 (hereinafter "Ong"). Claims 1, 4 to 7 and 21 stand rejected under 35 U.S.C. §102(b) as allegedly anticipated by Luque de Castro (1999) Trends in Analytical Chem. 19:708-716. Claims 1, 12 and 21 stand rejected under 35 U.S.C. §102(b) as allegedly anticipated by Wright, et al., USPN 5,087,360, issued February 11, 1992.

Applicants respectfully traverse all outstanding objections to the specification and rejection of the claims. Reconsideration of the pending claims is respectfully requested.

Restriction Requirement and Election

In the restriction requirement dated June 17, 2004, the Patent Office alleged that the pending claims of the application were directed to two separate and distinct inventions under 35 U.S.C. §121. Applicants elected Group I, claims 1 to 21 (claim 22 was amended to depend from claim 1), drawn to a method for solvent extraction, with traverse. Applicants set forth distinct and specific errors in the restriction requirement and reasons for the Patent Office to reconsider and

sd-240250

BEST AVAILABLE COPY

Application No.: 09/991,151

10

Docket No.: 532782000100

withdraw the restriction requirement. Accordingly, Applicants have preserved their right to petition the restriction to the Group Director under 37 CFR §1.144; see also MPEP §818.03(c); pg 800-60, 8th Edition, rev. 2, May 2004. Applicants will defer submission of the petition (which can be deferred until allowance of the claims).

Support for the Claim Amendments

The specification sets forth an extensive description of the invention in the new and amended claims. For example, support for claims directed to methods wherein the sample comprises a solid or a semi-solid sample can be found, inter alia, on page 3, in the second paragraph of the Summary. Support for claims directed to methods wherein microwave energy is or is not used, and optionally is used to heat the sample, the solvent or the extraction cell, can be found, inter alia, on page 3, in the third paragraph of the Summary. Support for claims directed to methods wherein the solvent is maintained under the regulated pressure or pressure range by an in-line back pressure regulator positioned downstream of the extraction cell can be found, inter alia, on page 3, in the second paragraph of the Summary (see lines 8 to 10 of the paragraph). Support for claims directed to methods wherein the analytical device comprises a capillary electrophoresis (CE) or a high performance liquid chromatography (HPLC) can be found, inter alia, on page 5, first paragraph of the Detailed Description. Accordingly, no new matter has been added by way of these amendments and support for each amendment can be found in the original claims as filed and throughout the specification.

Issues under 35 U.S.C. §102(a)

Claims 1 to 21 stand rejected under 35 USC §102(a) as allegedly anticipated by Ong (2000) J. Chromatography 313:57-64.

The legal standard for anticipation under 35 U.S.C. §102 is one of strict identity. To anticipate a claim, a single prior source must contain each and every limitation of the claimed invention.

Applicants respectfully traverse. However, Applicants submit a declaration under 37 CFR §1.132 establishing that the Ong article is describing the named inventors' own work, i.e., the

sd-240250

Application No.: 09/991,151

11

Docket No.: 532782000100

work of co-inventors Eng-Shi Ong, Soo-On Woo, Yuk-Lin Yong and Siti Norasikin binte Apandi (see inventor's declaration submitted November 16, 2001).

Applicant may overcome a rejection under 35 U.S.C. §102(a) by filing a specific affidavit or declaration under 37 CFR §1.132 establishing that the article is describing applicant's own work. In re Katz, 687 F.2d 450, 215 USPQ 14 (CCPA 1982). MPEP §715.01(c), page 700-243, 8th Edition, Rev. 2, May, 2004. Applicant's disclosure of his or her own work within the year before the application filing date cannot be used against him or her under 35 U.S.C. §102(a). MPEP §2132.01, page 2100-78, 79, 8th Edition, Rev. 2, May 2004.

In the attached Rule 132 declaration, co-inventors Eng-Shi Ong, Soo-On Woo, Yuk-Lin Yong and Siti Norasikin binte Apandi declare that Ong (2000) J. Chromatography 313:57-64 ("the Ong (2000) article") is describing their own work. It is declared that all the named co-inventors Eng-Shi Ong, Soo-On Woo, Yuk-Lin Yong and Siti Norasikin binte Apandi were involved in the work described in the Ong (2000) article, and all the named co-inventors Eng-Shi Ong, Soo-On Woo, Yuk-Lin Yong and Siti Norasikin binte Apandi should have been co-authors on the Ong (2000) article, but it was by administrative error only that Siti Norasikin binte Apandi was not named as a co-author. Applicants note that all the named co-inventors Eng-Shi Ong, Soo-On Woo, Yuk-Lin Yong and Siti Norasikin binte Apandi have previously declared themselves to be co-inventors in the "declaration for utility patent application" submitted with the filing of the instant application on November 16, 2001.

Applicants make it of record that this declaration is being submitted merely to expedite prosecution of this application. Submission of this declaration under 37 CFR §1.132 is neither a concession nor an admission that the claims under examination are anticipated by Ong.

Accordingly, the rejection of claims 1 to 21 under 35 USC §102(a) as allegedly anticipated by Ong can be properly withdrawn.

sd-240250

Application No.: 09/991,151

12

Docket No.: 532782000100

Issues under 35 U.S.C. §102(b)

Claims 1, 4 to 7 and 21 stand rejected under 35 U.S.C. §102(b) as allegedly anticipated by Luque de Castro (1999) Trends in Analytical Chem. 19:708-716.

The legal standard for anticipation under 35 U.S.C. §102 is one of strict identity. To anticipate a claim, a single prior source must contain each and every limitation of the claimed invention.

Claim 1, as amended, is directed to methods for solvent extraction of an organic analyte from a sample comprising, inter alia, contacting the sample with a preheated organic solvent system comprising an extraction fluid, wherein the extraction fluid is under conditions comprising elevated temperature and regulated pressure within a specified range or at a specified value to non-selectively extract the analytes, and the organic solvent system is in liquid form under conditions comprising elevated temperature and pressure during extraction.

The Patent Office alleges that Luque de Castro discloses a method for solvent extraction of analytes from plant samples comprising contacting a sample in an extraction cell with a preheated organic solvent as an extraction fluid under elevated temperatures and pressures to extract analytes from the samples, citing primarily pages 711 to 712 of Luque de Castro.

However, Luque does not disclose a method for solvent extraction of analytes comprising preheating an organic solvent as an extraction fluid. Pages 711 to 712 of Luque de Castro, in the section entitled CSWE, or “continuous subcritical water extraction”, is a technique based on the use of heated water (an aqueous solvent) as an extraction fluid. No preheated organic solvent is used as an extraction fluid in CSWE, or any other technique taught by Luque de Castro.

Luque de Castro does discuss methods using organic solvents, inter alia, in the section entitled “Discontinuous convention techniques”, page 709. However, none of these methods comprise preheating an organic solvent as an extraction fluid.

Because Luque de Castro does not teach, inter alia, a method for solvent extraction of analytes comprising preheating an organic solvent as an extraction fluid, it is not a single prior

sd-240250

Application No.: 09/991,151

13

Docket No.: 532782000100

source that contains each and every limitation of the claimed invention. Accordingly, the rejection of claims 1, 4 to 7 and 21 under 35 USC §102(b) as allegedly anticipated by Luque de Castro can be properly withdrawn.

Additionally, Luque de Castro concludes (please note the "Conclusions" section, page 714) that several techniques, including organic solvent extraction, are difficult or impossible to manipulate in order to obtain a product with the desired characteristics.

Issues under 35 U.S.C. §102(b)

Claims 1, 12 and 21 stand rejected under 35 U.S.C. §102(b) as allegedly anticipated by Wright, et al., USPN 5,087,360, issued February 11, 1992.

The legal standard for anticipation under 35 U.S.C. §102 is one of strict identity. To anticipate a claim, a single prior source must contain each and every limitation of the claimed invention.

Claim 1, as amended, is directed to methods for solvent extraction of an organic analyte from a sample comprising, inter alia, contacting the sample in an extraction cell with a preheated pressure-regulated organic solvent system comprising an extraction fluid, wherein the extraction fluid in the extraction cell is under conditions comprising elevated temperature and regulated pressure within a specified pressure range or at a specified pressure value to non-selectively extract the analytes, and the solvent in the extraction cell is maintained under the regulated pressure or pressure range by an in-line back pressure regulator positioned downstream of the extraction cell. The downstream positioning of an in-line back pressure regulator, or equivalent, is important in maintaining a regulated pressure or pressure range in the extraction cell.

Wright does not teach a method or system regulating pressure or pressure ranges in the extraction cell by means of an in-line back pressure regulator positioned downstream of the extraction cell. In Wright, a pressure control module is placed inside a high pressure pump positioned upstream of the extraction cell (see, e.g., column 5, lines 16 to 33). By nature of the upstream positioning of the pressure control module, the method and apparatus of Wright cannot

sd-240250

Application No.: 09/991,151

14

Docket No.: 532782000100

maintain the regulated pressure that is possible when an in-line back pressure regulator, or equivalent, is positioned downstream of the extraction cell.

Because Wright does not teach, inter alia, a method or system regulating pressure or pressure ranges in the extraction cell by means of an in-line back pressure regulator positioned downstream of the extraction cell, it is not a single prior source that contains each and every limitation of the claimed invention. Accordingly, a rejection of claims 1, 12 and 21, as amended, under 35 USC §102(b) as allegedly anticipated by Wright can be properly withdrawn.

sd-240250

Application No.: 09/991,151

15

Docket No.: 532782000100

* * * * *

CONCLUSION

* * * * *

In view of the foregoing amendment and remarks, Applicants respectfully aver that the Examiner can properly withdraw the rejection of the pending claims under 35 U.S.C. §102(a) or §102(b). In view of the above, claims in this application after entry of the instant amendment are believed to be in condition for allowance. Accordingly, the Examiner is respectfully requested to withdraw the outstanding rejections of the claims and to pass this application to issue.

In the unlikely event that the transmittal letter is separated from this document and the Patent Office determines that an extension and/or other relief is required, applicants petition for any required relief including extensions of time and authorize the Assistant Commissioner to charge the cost of such petitions and/or other fees due in connection with the filing of this document to Deposit Account No. 03-1952 referencing docket No. 532782000100.

As noted above, Applicants have requested a telephone conference with the undersigned representative to expedite prosecution of this application. After the Examiner has reviewed the instant response and amendment, please telephone the undersigned at 858 720 5133.

Dated: January 21, 2005

Respectfully submitted,

By 

Gregory P. Vinhorn

Registration No.: 38,440

MORRISON & FOERSTER LLP

3811 Valley Centre Drive, Suite 500

San Diego, California 92130

(858) 720-5133

sd-240250

**This Page is Inserted by IFW Indexing and Scanning
Operations and is not part of the Official Record**

BEST AVAILABLE IMAGES

Defective images within this document are accurate representations of the original documents submitted by the applicant.

Defects in the images include but are not limited to the items checked:

- ☐ BLACK BORDERS
- ☐ IMAGE CUT OFF AT TOP, BOTTOM OR SIDES
- ☐ FADED TEXT OR DRAWING
- ☐ BLURRED OR ILLEGIBLE TEXT OR DRAWING
- ☐ SKEWED/SLANTED IMAGES
- ☐ COLOR OR BLACK AND WHITE PHOTOGRAPHS
- ☐ GRAY SCALE DOCUMENTS
- ☒ LINES OR MARKS ON ORIGINAL DOCUMENT
- ☐ REFERENCE(S) OR EXHIBIT(S) SUBMITTED ARE POOR QUALITY
- ☐ OTHER: _____

IMAGES ARE BEST AVAILABLE COPY.

As rescanning these documents will not correct the image problems checked, please do not report these problems to the IFW Image Problem Mailbox.